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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/605,567	02/22/96	WOODWARD	D 16955DIV2CIP
			EXAMINER

12M2/0401

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ART UNIT	PAPER NUMBER
CEBULAK, M	1209

DATE MAILED: 04/01/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 9/13/96

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 11 is/are allowed.
- ☒ Claim(s) 1-10 & 12-25 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Status of Claims

1. Claims 1-25 are pending in this application.

Claim Rejections - 35 USC § 112

2. Claims 7, 17, 9 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 7 and 17 recite the limitation "Y is O" and "X is selected from the group consisting of alkoxy and amido". There is insufficient antecedent basis for this limitation in the claim. Specifically, Y is never defined as O and X is never defined as amido. Further, claims 7 and 17 are dependent upon claim 5 which uses the variable Y¹ not Y.

Claims (herein claims 9 and 19) which depend from an indefinite claim are also indefinite. Ex parte Cordova, 10 U.S.P.Q.2d 1949, 1952 (P.T.O. Bd. App. 1952).

Double Patenting

4. Applicant is advised that should claims 2-10 be found allowable, claims 12-20 will be rejected under 35 U.S.C. 101 as being a substantial duplicates thereof respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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5. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and © may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3 and 12-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,352,708.

Although the conflicting claims are not identical, they are not patentably distinct from each other because there is substantial overlap of the subject matter patented in 5,352,708 and that claimed herein.

7. Claims 1-3 and 12-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,607,978.

Although the conflicting claims are not identical, they are not patentably distinct from each other because there is substantial overlap of the subject matter patented in 5,607,978 and that claimed herein.

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8. Claims 1-7, 9, 12-17, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,545,665. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is substantial overlap of the subject matter patented in 5,545,665 and that claimed herein.

9. Claims 1-3 and 12-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,587,391. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is substantial overlap of the subject matter patented in 5,587,391 and that claimed herein.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action;

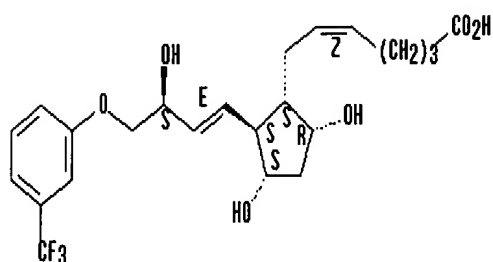
A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

11. Claims 1-4, 8, 10, 12, 13, 14, 18, and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Bishop et al. (US 5,510,383 hereafter "Bishop").

Bishop discloses the compound fluprostenol:

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which is disclosed as being useful for the treatment of glaucoma and ocular hypertension. While Applicants have a effective filing date of 9/21/92, the compound with CF_3 as the substituent on the phenyl was not disclosed therein. Applicants first disclosed this compound in the present application filed, 2/22/96. Further, the only support Applicants have for the O-alkenylene linking moiety (the A portion of formula I) is in the present application and in examples 8, 9, and 15 of patent US 5,352,708 (application 07/948,056 parent application to the present application). Applicant is afforded the filing date of 2/22/96 for the above compound. Therefore, to prepare this compound and use it for the treatment of ocular hypertension is anticipated by Bishop as the reference discloses the compound fluprostenol in an ophthalmic composition for the treatment of glaucoma and ocular hypertension.

NOTE: It appears that Applicants have support for the compound cloprostenol in the parent application 07/948,056 filed 9/21/92.

12. The following is a statement of reasons for the indication of allowable subject matter: It does not appear that the method of using the compounds of formula I for the treatment of

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cardiovascular pulmonary-respiratory, gastrointestinal, reproductive or allergic disease is disclosed or taught in the prior art.

13. Papers related to this application may be submitted to Group 1200 by facsimile transmission. Papers should be faxed to Group 1200 via (703)308-4556. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner M. Cebulak at (703)308-4520. Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix Customer Service Center at (703)308-1235.

If the undersigned cannot be reached, please contact the Examiner's supervisor, José Dees, at (703) 308-4628.



Mary C. Cebulak
Patent Examiner
Group 1200